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EXAMINER

LE, KHANH H

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/089,996	<b>Applicant(s)</b> NAGAOKA ET AL.	
	<b>Examiner</b> KHANH H. LE	<b>Art Unit</b> 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 December 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 18-20, 24-30 and 54 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 18, 19, 20, 24-30, 54 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **Detailed Action**

1. This Office Action is responsive to the Response dated 12/20/2007. Claims 18-43, 45-46, 48-55 are pending. Applicants have amended claims 18-23, and 25. Claims 21, 22-23, 31-43, 45-46, 48-53, 55 are withdrawn. Thus claims 18, 19, 20, 24-30, 54 are now examined. Of these, claim 18 is independent.

### ***Response to Arguments***

2. Applicant's arguments have been fully considered and are partly persuasive. The term "mobile" was previously broadly interpreted as movable or portable, based on Applicant's lack of commitment to any special definition. All that is disclosed is at [0008] :..."The mobile terminal may be a mobile phone, for example. "

Contrary to argument, the cables in Holman do not stop Holman's home unit from being movable or portable, since cables can be plugged into PDAs and cell phones, as well, for data transfer or just recharging. However, "mobile" might have a slightly different definition in the art, more than just portable or movable, thus it is hereby interpreted as suggesting cell phones or PDAs. "Mobile communications" might suggest the same. Thus the previous rejection based on anticipation by Holman, US 5,287,181 is withdrawn.

However, upon further consideration, a new ground of rejection is presented as follows.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject

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matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**4. Claims 18, 19, 20, 24-29, 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Holman, US 5,287, 81 in view of Official Notice and/or legal precedent.**

Holman discloses (independent claim 18):

A movable terminal (home unit for extracting e-coupons to be stored onto magnetic cards from TV signals: see abstract, Figures 1, 2 and associated text; col. 5 lines 40-50 describe the mag. card which is used to present downloaded coupons at points of sale (POS's), see e.g.col.4 lines 39-47) for use in a broadcasting system, comprising a broadcast station (col. 6 lines 5-27), the terminal comprising:

interactive device interface specifically configured to communicate with an interactive device (Figure 1 items 33, 10 or 40; Fig 2: the interactive device being a cable box, TV, or VCR, col. 5 lines 9-12) for receiving broadcast information from the broadcast station;

interactive device control (Fig 3 items 43, 150, 117: system of home unit including remote control and/or keypad and control unit described in detail in Figure 4) configured to instruct the interactive device via the interactive device interface to control reception and reproduction of the broadcast information by the interactive device and forwarding of selected information in the broadcast information to the movable terminal from the interactive device (see abstract, Figures 1, 2 and associated text);

request generator\_(e.g. Fig 3 items 43, 150, remote control and/or keypad and components, e.g.

Figure 4, items 151, 205) configured to generate a user request for incentive information (e.g. Figure 4 item 207: “view” coupon request) for promoting a service found in the broadcast information;

request sender (e.g. Fig 3 items 43, 150, remote control and/or keypad and components, e.g. Figure 4, items 151, 205) configured to transmit the user request for incentive information wherein the user request which is receivable by a management system (e.g. Figure 3 item 117: the management system being the control circuit, described in detail in Figure 4 and associated text);

incentive information receiver (e.g. Fig 3 item 128: memory in home unit; col. 6 lines 24-27; col. lines; 10 lines 45-48) configured to so that the terminal receive the incentive information returned from the management system;

incentive information storage (Fig 3 item 128: memory in home unit; col. 6 lines 24-27; col 10 lines 45-48) configured to store the incentive information returned from the management system;

communication network interface configured to communicate via a communication network with a service facility that provides the service ( i.e. via the mag card, col. 4 lines 39-47);

and

incentive information presenter (col. 4 lines 58-68; col. 11 lines 17-22; magi cards or the like) configured to present the stored incentive information to the service facility in order to receive the promoted service from the service facility (col. 4 lines 39-47);.

**Holman’s portable home terminal with its mag card reader to download coupons to the mag card is arguably not a mobile terminal and communication via a mobile communication network is thus not disclosed in Holman.**

**However it is known at the time of invention that the following types of user devices or terminals, wired or mobile, can all be used interchangeably to receive/transfer data including incentives or coupons data.**

For example,

Kolls US 6601040 in e-commerce/coupons scheme discloses interchanging smart card reader/writers with magnetic card reader/writers and other devices (col. 14 lines 25-29) to access/transfer data;

Freeman US 6450407 B1 discloses rebates or discounts are downloaded to a customer's chip card via a multiplicity of possible channels including: a personal computer, a portable chip card reader, a point-of-sale (POS) terminal, a handheld device, a home or business telephone, a vending machine, a cellular phone, a pager, a mass transportation payment station, a television and/or television set-top box, or an automated teller machine (ATM) (abstract) and cell phones with chip card communication ports (col. 8 lines 23-31);

Aggarwal US 7013286 B1 in a generation, distribution, storage, redemption, validation and clearing of electronic coupons scheme, discloses

*“In another embodiment, the customer obtains electronic coupons and at a later stage, he or she downloads the electronic coupon in a portable device such as floppy disk, magnetic tape, compact disk, personal digital assistant, portable smart-card, cellular phone, etc., and takes the portable device to a retailer where the coupon verification equipment reads the electronic coupon from the portable device either using a wired communication channel or a wireless channel. The verification equipment then checks the validity of the coupon. If the coupon is valid, the retailer gives the intended discount to the customer.”*

Further it is a trend in the art for everybody to go mobile and do things on phones/PDAs that used to be done in home systems.

*Leapfrog v. Fisher-Price* (Fed. Cir. 2007) affirming a finding of obviousness, had addressed the issue of adoption of trends in the art, which is relevant in our case.

(This is the first application of the Supreme Court's obviousness pronouncement in *KSR v. Teleflex* by the Court of Appeals for the Federal Circuit (CAFC))

Leapfrog and Fisher-Price compete in the toy market. In this case, Leapfrog sued Fisher-Price -- alleging that Fisher-Price's PowerTouch Learning System infringes claim 35 of Leapfrog's patent.

The trial court found the patent not-infringed and **invalid as obvious**. On appeal, the CAFC affirmed, noting that the **obviousness analysis requires a common sense approach rather than any rigid formula**.

The CAFC held:

*“An obviousness determination is not the result of a rigid formula disassociated from the consideration of the facts of a case. Indeed, the common sense of those skilled in the art demonstrates why some combinations would have been obvious where others would not. See KSR Int’l Co. v. Teleflex Inc., 550 U.S. \_\_ (2007) (“The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.”)*

This case has serious and direct implication for the instant application. The two pieces of prior art in Leapfrog were Bevin (electro-mechanical, but not electronic, toy for phonetic learning) and SSR (electronic book-type toy). Together, the two references teach almost all the elements of the asserted claim, and the courts found their combination to be appropriate.

The Court further held (emphasis added):

*We agree with the district court that one of ordinary skill in the art of children's learning toys would have found it **obvious to combine the Bevan device with the SSR to update it using modern electronic components in order to gain the commonly understood benefits of such adaptation, such as decreased size, increased reliability, simplified operation, and reduced cost.** While the SSR only permits generation of a sound corresponding to the first letter of a word, it does so using electronic means. **The combination is thus the adaptation of an old idea or invention (Bevan) using newer technology that is commonly available and understood in the art (the SSR).** We therefore also find no clear error in the finding of the district court that **one of ordinary skill in the art could have utilized the electronics of the SSR device, with the method of operation taught by Bevan, to allow a child to press each individual letter in a word and hear the individual phonemes associated with each letter to sound out the words.***

***The one remaining limitation -- a "reader" -- was "well-known in the art at the time of the invention" and its combination. That known element could be combined because it provides "an added benefit and simplified use of the toy for the child in order to increase its marketability."***

*....Leapfrog presents no evidence that the inclusion of a reader in this type of device **was uniquely challenging or difficult for one of ordinary skill in the art.** Nor does Leapfrog present any evidence that **the inclusion of a device commonly used in the field of electronics (a reader), and even in the narrower art of electronic children's toys, represented an unobvious step over the prior art.**" )*

Here, replacing the home unit of Holman with a cell phone or PDA is the adaptation of an old idea or invention (Holman) using newer technology that is commonly available and understood in the art (the cellphone or PDA). As reasoned in Leapfrog, one of ordinary skill in the art could have utilized the electronics of the cellphone or PDA, with the method of operation taught by Holman, to allow the user *an added benefit such as* convenience or mobility in the use



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of the promotion system taught by Holman thereby increasing its appeal or marketability to the user. There is no evidence the combination is uniquely challenging or difficult for one of ordinary skill in the art thus the combination is obvious.

In view of the interchangeability of user devices as has been done in the prior art discussed above, and/or in view of the legal precedent of Leapfrog as discussed above, it would have been obvious to a person having ordinary skill in the art at the time the invention was made (herein a "PHOSITA") to replace the home unit including the mag. card interface of Holman with a cell phone with chip card communication ports as taught by Freeman or with a portable phone as taught in Aggarwal. In case a portable phone is used, a mobile communication network interface configured to communicate via a mobile communication network with a service facility that provides the service as claimed will be used as taught by Aggarwal (citation above), to allow the user the benefit of convenience or mobility in the use of the promotion system taught by Holman thereby increasing its appeal or marketability to the user.

**Claims 19, 20, 54:**

Holman modified as above discloses a terminal as in Claim 18 above and further discloses  
user request sent and incentive information received via the interactive device (col. 6 lines 5-27).

**Claims 24:**

Holman modified as above discloses a terminal as in Claim 18 above and further discloses  
a memory for storing personal information, wherein the personal information is communicated to the management system, along with the user request (col.14 lines 11-17).

**Claims 26 and 27:**

Holman modified as above discloses a terminal as in Claim 18 above and further discloses the incentive information comprises a request to render a service (the request is interpreted as a coupon as suggested by applicants) or a redeemable promotion (abstract: e-coupon).

**Claim 29:**

Holman modified as above discloses a terminal as in Claim 18 above and further discloses the incentive information presenter communicates at least a part of the incentive information to the service facility via the mobile communication network (col. 4 lines 39-47).

**Claim 28:**

Holman modified as above discloses a terminal as in Claim 18 above and further discloses the user request comprises a qualification for the user to receive the incentive information (col. 13 line 40 to col.14 line 2).

**Claim 25:**

Holman modified as above discloses a terminal as in Claim 18 above but does not disclose wherein the user request comprises a form to be filled with information by a user, and the user interface comprises a keypad for inputting data into the form. However Holman discloses a form filled out by a user to subscribe to the coupon service based on which a subscription data card is generated (col. 16 lines 44-60) for inputting user data into the e-coupon system which is periodically updated (col. 17 lines 7-9).

Because Holman suggests other electronic means instead of the subscription data card for inputting consumer data into the system are possible alternatives (col. 16 lines 49-50), and because input of data via remote control is known at the time of the invention, it would have been obvious to one skilled in the art at the time the invention was made to modify Holman's system with inputting user data via a keypad.

**5. Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Holman as applied to claim 18 above, and further in view of Freeman et al. US 6450407.**

**Claim 30:**

Holman modified as above discloses a terminal as in Claim 18 above but does not disclose the interactive device comprises a set-top box, and the interactive device interface comprises a set-top box interface.

However Freeman, in a similar e-coupon on chip cards scheme, discloses a set top box is an alternate device to a television or other consumer devices as conduits for delivering e-coupons (abstract, col. 10 lines 7-22). Thus it would have been obvious to one skilled in the art at the time the invention was made to replace Holman's television with an STB as alternate delivery device as taught by Freeman.

***Conclusion***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khanh H. Le whose telephone number is 571-272-6721. The Examiner works a part-time schedule and can normally be reached on Tuesday-Wednesday 9:00-6:00.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The fax phone numbers for the organization where this application or proceeding is assigned are **571-273-8300** for regular communications and for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose

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telephone number is 571-272-3600. For patent related correspondence, hand carry deliveries must be made to the Customer Service Window (now located at the Randolph Building, 401 Dulany Street, Alexandria, VA 22314).

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Khanh H. Le/  
Examiner, Art Unit 3622  
February 29, 2008

/James W Myhre/  
Primary Examiner, Art Unit 3622